

REMARKS

The present amendment is submitted in response to the final Office Action mailed November 16, 2006.

Claim 14 has been amended in a manner which is believed to overcome the rejection under 35 U.S.C. 112, second paragraph. Withdrawal of this rejection is respectfully requested.

Claims 12-16, 19 and 23 stand rejected under 35 U.S.C. 102(e) by U.S. Patent No. 6,436,105 to Passmore. Passmore '105 is not prior art to the present application. In particular, the present application claims priority to U.S. Patent Application Serial No. 09/809,521, filed on March 15, 2001, now U.S. Patent No. 6,685,719, which claims the benefit of U.S. Provisional Application No. 60/189,392 filed on Mar. 15, 2000. The priority information is readily available on the PAIRS System. In addition, Applicant submitted a Preliminary Amendment with the filing of this application where the specification was amended to properly claim priority to the parent and provisional applications. A copy of the Preliminary Amendment and the Postcard acknowledging receipt of same is attached hereto and is also located on the PAIRS system. Accordingly, withdrawal of this rejection is respectfully requested.

In addition, Applicant hereby requests that the specification be amended to properly identify the priority applications as set forth in the Preliminary Amendment.

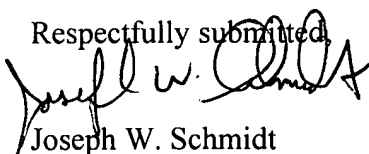
With regard to the rejection under the judicially created doctrine of obviousness-type double patenting, a Terminal Disclaimer is submitted herewith.

In view of the foregoing amendments and remarks, reconsideration of the rejection and objections and allowance of the claims are earnestly solicited. Accordingly, early and favorable reconsideration of this application is respectfully requested. Should the Examiner feel that a telephone or personal interview may facilitate resolution of any remaining matters, she is respectfully requested to contact Applicant's attorney at the number indicated below.

It is respectfully submitted that none of the references of record disclose or suggest the present invention as claimed in the claims as amended, considered individually or in combination, with themselves, considered in whole or in part. Accordingly, withdrawal of the rejections and objections is respectfully requested.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. §1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-2140. TWO (2) COPIES OF THIS SHEET ARE ENCLOSED.

Respectfully submitted,



Joseph W. Schmidt
Reg. No. 36,920
Attorney for Applicant

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road, Suite 225
Melville, New York 11747
(631) 501-5703
(631) 501-3526 (fax)
JWS/td

PATENT

Attorney Docket: 1021-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): James R. Matera, Jr. Examiner: Alissa L. Hoey
Serial No.: 09/809,521 Group: Art Unit 3765
Filed: March 15, 2001 Dated: January 14, 2004
For: SURGICAL TATTOOING APPARATUS AND METHOD

MAIL STOP: PATENT APPLICATION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRELIMINARY AMENDMENT

Sir:

Prior to examination of the above-identified application, please amend the application as set forth herein below.

Amendments to the Specification begin on page 2 of this paper.

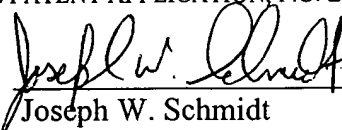
Amendments to the Claims are reflected in the listing of claims beginning on page 3 of this paper.

The Remarks begin on page 6 of this paper.

CERTIFICATION UNDER 37 C.F.R. §1.10

I hereby certify that this correspondence and the documents referred to as enclosed are being deposited with the United States Postal Service on date below in an envelope as "Express Mail Post Office to Addressee" Mail Label Number EL985195769US addressed to: Commissioner for Patents, Mail Stop PATENT APPLICATION, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: January 14, 2004



Joseph W. Schmidt

Amendments to the Specification:

At page 1, before the section entitled "Background", please insert the following paragraph:

CROSS REFERENCE TO RELATED APPLICATION

This application is a continuation application of application Serial No. 09/809,521, filed March 15, 2001, which claims the benefit of U.S. Provisional Application No. 60/189,392 filed March 15, 2000. The contents of the disclosures of the '521 application and the '392 provisional application are incorporated in their respective entireties by reference herein.

Amendments to the Claims:

The listing of claims will replace all prior versions, and listings of claim in the application.

Claims 1-10 (canceled)

Claim 11 (new). A surgical procedure, comprising the steps of:
positioning an ink dispensing instrument having sterilized tattoo ink therein adjacent a patient;

releasing said tattoo ink through a port of said ink dispensing instrument and onto body tissue of a patient to selectively mark the body tissue to generally correspond to a target location for radiation therapy; and

dispensing said ink dispensing instrument after use on the patient.

Claim 12 (new). A surgical ink dispensing instrument for facilitating surgical tattooing of a patient, which comprises:

an ink cartridge defining an enclosed internal chamber; and
sterile tattoo ink disposed within said enclosed internal chamber of said ink cartridge.

Claim 13 (new). The surgical instrument according to claim 12 wherein said ink cartridge defining^{es} a port in communication with said internal chamber.

Claim 14 (new). The surgical instrument according to claim 13 including an enclosure for covering said port of said ink cartridge.

Claim 15 (new). The surgical instrument according to claim 14 wherein said enclosure is releasably mounted to said ink cartridge.

Claim 16 (new). The surgical instrument according to claim 15 wherein said enclosure is an end cap, said end cap being removably mounted to said ink cartridge adjacent said port.

Claim 17 (new). The surgical instrument according to claim 12 wherein said ink cartridge is substantially flexible to permit the operator to manually deform said ink cartridge by direct engagement of said ink cartridge with a hand of the operator to dispense said tattoo ink through said port.

Claim 18 (new). The surgical instrument according to claim 12 including a surgical needle mounted to said ink cartridge.

Claim 19 (new). The surgical instrument according to claim 18 wherein said surgical needle defines a lumen in communication with said port of said ink cartridge.

Claim 20 (new). A single use surgical ink dispensing instrument for facilitating surgical tattooing of a patient, which comprises:

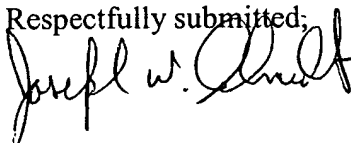
- an ink cartridge defining an internal chamber;
- sterile tattoo ink disposed within said internal chamber of said ink cartridge; and

wherein, subsequent to dispensing said sterile tattoo ink on body tissue of a patient to mark the tissue for radiation therapy, said ink cartridge is discarded.

REMARKS

Claims 11-20 are pending in this application. Early and favorable consideration is respectfully requested.

Respectfully submitted;

A handwritten signature in black ink, appearing to read "Joseph W. Schmidt", written over the typed name.

Joseph W. Schmidt
Attorney for Applicant
Reg. No. 36,920

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road, Suite 225
Melville, New York 11747
Tel: (631) 501-5700
Fax: (631) 501-3526